

parag [006] of our previous Response.

The examiners have not presented any explanation why this objection has been continued, despite our explanation. We request, again, that the objection be withdrawn.

[005]        Rejection of claim 19 under 35.USC.112, 2nd§

The test for whether claim 19 is bad for not defining the invention, under the 2nd§, is this:-

Claim 19 would be bad if a procedure P can be tabled, about which the skilled person would be unable, because of the lack of defining words in claim 19, to determine whether that procedure P does or does not fall within the scope of claim 19. If no such procedure P can be tabled, claim 19 is good (at least as far as the 2nd§ is concerned).

Claim 19 was written from the standpoint that it must pass the above test. No other test is sanctioned under the statute. Claim 19 was not written on the basis that it would have to pass any other kind of "defining-the-invention" test.

Applicants cannot envisage any procedure P, about which the skilled persons would be unable to determine whether procedure P does or does not fall within the scope of claim 19. The examiners have not tabled any such procedure.

In order for claim 19 to read onto a procedure P, procedure P must (among other things) include providing an apparatus that falls within the scope of claim 1. We cannot envisage how the skilled persons, upon providing an apparatus, would or might possibly have difficulty determining whether that apparatus does or does not fall within the scope of claim 1. The examiners have not tabled an example of such an apparatus.

The examiners suggest that an **apparatus falling within the scope of claim 1 could include some of the recited structure or all of the recited structure**. An example of an apparatus that does include all of the structure recited in claim 1 is the apparatus we depict in Fig.1, with the various details of Figs.3-6. The examiners have not tabled any actual example of an apparatus that (a) falls within the scope of claim 1, and yet (b) does not include all the recited structure. The applicants cannot imagine what apparatus the examiners might have in mind, here.

Accordingly, with respect, we put the PTO to it:- either table an example of a procedure P, about which, as a whole, the skilled persons would not be able to determine whether procedure P does or does not fall within the scope of claim 19 -- or withdraw the Rejection of claim 19.

The examiners assert (in the *Response to Arguments* section of the O/A) that the RICKS Abstract discloses a valve that falls within the scope of claim 1.

But the valve disclosed in RICKS is manually operated. To be sure, when the valve is opened (manually), any pressure differential will be dissipated.

Clause [11] of claim 1 requires that the valve operator (introduced in clause [10] as a structural component of the apparatus as claimed) is effective to operate the valve in response to a change in the pressure differential between the air in the vault and the air outside the vault.

We state again our position, that the valve disclosed by RICKS is operated manually. Therefore, the RICKS valve does not contain structure that falls within the scope of the words **the operator is effective to operate the valve in response to a change in the pressure differential**.

The examiners, by way of explanation of their position, present the following statement, namely:- the claim does not specify how the valve opens/closes in response to a pressure differential.

This statement is quite correct, as far as it goes. In order for an apparatus to fall within the scope of claim 1, the apparatus must include a valve operator that is effective to operate the valve in response to a change in the pressure differential. But claim 1 is limited simply to the fact that the operator is responsive in the pressure differential. Claim 1 contains no limitation as to how the valve opens/closes in response to the pressure differential.

The applicants wonder how the skilled persons might possibly imagine that the RICKS valve, as a whole structural apparatus, has an operator that meets the words of clause [11] of claim 1. Perhaps the examiners are thinking that the human operator, in a RICKS apparatus, is actually a component of the RICKS apparatus -- whereby the component of the apparatus that operates the valve in response to pressure differential is the brain function of the human operator?

If the examiners are thinking that way, we request that they say so. If the examiners have in mind some other way of construing claim 1, in which claim 1 reads onto RICKS, they should, with respect, explain that. It seems perfectly clear that the RICKS valve operator clearly does NOT respond to changes in pressure, in order to operate the valve, because the RICKS valve is manually operated.

If the examiners were to decide to continue the '102 Rejection of claim 1, based on RICKS, the applicants would request the examiners to supply a carefully-reasoned explanation how/why the structure of the apparatus of the RICKS valve, as disclosed, would or might be regarded, by the skilled

persons, as falling within the scope of clause [11] of claim 1.

The examiners also make the following statement:-

Further, Examiner notes new claim 20 (dependent on claim 1) discloses it is the pressure differential that urges the valve in a open/closed position. Accordingly, applicant's arguments appear to be directed to the new claim 20.

This statement is presented as part of the examiners' reasoning for their Rejection of claim 1. Again, our claim 1 is limited by thefact that the valve operates in response to a change in the pressure differential. RICKS does not have that. We cannot see how the reference to claim 20 has any relevance in that regard.

[007]        Rejection of claim 1 under 35.USC.103 - ROSSINI v RICKS

On page 18 of the O/A, the examiners note that ROSSINI does not explicitly disclose sealing means for sealing the panes of glass to the spacer structure. Nevertheless, we would have to say that sealing is implied in the ROSSINI apparatus. The pressure differential mentioned by ROSSINI could not be present, in the ROSSINI apparatus, unless the panes were sealed. Therefore, there is no need to invoke RICKS in order to teach the sealing of the panes.

The examiners note that the ROSSINI apparatus, as actually disclosed, falls outside the words of clause [11] of our claim 1, in that the ROSSINI valve does not lie in a through-hole in one of the glass panes.

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The examiners have devised a variant of the ROSSINI apparatus, for the purposes of the Rejection of claim 1. In this variant, the valve assembly lies in a through-hole in one of the glass panes.

The examiners assert that the skilled designers of double-pane insulators would have found this variant obvious, because the act of making such a modification to the ROSSINI apparatus is an act simply of following the teachings of the prior art, namely of following the teachings of the RICKS apparatus. RICKS, of course, shows a valve assembly that lies assembled in a through-hole of one of the glass panes.

We note that there are a number of cautions expressed in ROSSINI, against mounting the ROSSINI valve horizontally. The ROSSINI valve relies on gravity to close the valve. Thus, a ROSSINI valve would never close, if it were oriented with its axis horizontal.

If the ROSSINI valve were to be mounted in a through-hole in one of the glass panes, it is inevitable that the axis of the ROSSINI valve would be horizontal.

It follows that, if the variant apparatus tabled by the examiners were to be actually put into practice, it would not work. At any rate, the variant would not work in the advantageous manner disclosed by ROSSINI.

The law is clearly established that, in the case of a new apparatus that is a variant of a disclosed apparatus, if the new apparatus performs less well than the disclosed apparatus, in terms of the performance of the functions attributable to the disclosed apparatus, then the new apparatus cannot be regarded as an obvious variant of the disclosed apparatus. In short, in such a case, the prior art *teaches away from* the modification needed in order to arrive at the new apparatus.

If the examiners were to decide to continue the '103 Rejection of claim 1, based on the variant they have devised of the ROSSINI apparatus, we would in that case ask the examiners to provide a carefully-reasoned explanation why/how the skilled persons would, as a result of *following* the teachings of the prior art, arrive at their variant apparatus. Absent such explanation, the '103 Rejection of claim 1 must be withdrawn.

[008]        Rejections of claim 1

Applicants request that the two Rejections of claim 1 be withdrawn, for the reasons as explained in the above Remarks.

If the examiners were to decide to continue one or both of the Rejections of claim 1, we would ask the examiners to supply a carefully-reasoned explanation why the Rejections can stand, in the light of the above carefully-reasoned Remarks. If the examiners' reasoning goes beyond what is expressed in the present O/A, of course the continued Rejection could not be made Final.

[009]        Rejection of dependent claims

All the claims depend from claim 1. Claim 1 being allowable, the rest of the claims also become allowable.

However, we make the following comment regarding the Rejection of the sub-claims. In the O/A, several of the many Rejections include the following expression as a component of the rejection:-

. . no new or unpredictable results would be expected . .

In fact, this statement by the examiners is -- with respect -- faulty. It is equivalent to saying:-

. . no unpredictable results would be predicted . .

Whether the skilled persons would or would not predict that a new

combination would have an unpredictable result, is clearly NOT a proper and decisive test to determine whether the new combination is obvious or inventive.

Obviousness, being the absence of inventiveness, is a negative property. It is difficult, generally, to "prove a negative" -- and there is no legal requirement for PO examiners to demonstrate how/why a new combination is obvious, in order to establish a *prima facie* case that the new combo is obvious. Generally, rather, it is up to the applicants to demonstrate how/why the new combination is inventive.

However, sometimes, as in this case, the examiners Reject a claim based on a positive assertion of obviousness. When the examiners do that, the positive assertion of obviousness, and the reasoning for it as expressed in the O/A, become elements of the *prima facie* case used by the examiners to justify the Rejection.

In that case, such *prima facie* case must be properly established. Accordingly, when the examiners do make a positive assertion of obviousness, it is open to applicants to respond to the Rejection by showing that the examiners' assertion of obviousness has not been properly established, as a *prima facie* case.

The examiners have Rejected the dependent claims based on their use of the expression

**.. no new or unpredictable results would be expected..** [from a new combination that falls within the scope of the claim].

The examiners have Rejected our subclaims, based on the failure of the subclaims to pass some such test as: *Would a new or unpredictable result be expected from this new combination?* As mentioned, whether or not the new combination is obvious, the answer to the question expressed in this form would (must) always be NO -- it is not possible for any result to be, at the same time, both *unpredictable* and *expected*.

The examiners would not have intended an absurdity, and the test they actually did use must have been something other than the test they expressed. In other words, one might guess that the test as expressed in the O/A was a slip of the pen.

There are two problems with the *slip-of-the-pen* interpretation. The first problem is that the test is expressed in this same way seven times, in the O/A. That being so, it can only be assumed that the wording must have been carefully considered by the examiners, upon being written down.

The second problem is that, even if the *slip-of-the-pen* interpretation is true, still the applicants are left to speculate just what test the examiners actually did use, when Rejecting our sub-claims. In this regard, of course, when Rejecting a claim in a patent application, the examiners have an obligation to supply the applicants with sufficient information about the Rejection to enable the applicants to make informed decisions

whether to argue against the Rejection, whether to amend the claims, etc.

In this case, it is not clear to the applicants just what test for obviousness the examiners actually did use, in Rejecting the various sub-claims. That being so, the prima facie case for obviousness has not been properly established. Accordingly, the status of the Rejections must be the same as if the Rejections had never been made.

If the examiners were to decide to continue the Rejections of the sub-claims, we would request the examiners to supply a carefully-reasoned explanation why the Rejections can stand, in the light of the carefully-reasoned Remarks herein. If the examiners' reasoning were to go beyond what is expressed in the present O/A, of course the continued Rejections could not be made Final.

[0011] This patent application being in all respects in condition for allowance, we look forward to being notified to that effect.

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Enclo: (none)